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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,155	05/31/2006	Lechong Chen	42P18673	1867
8791 7590 09/30/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
BUTLER, DENNIS				
ART UNIT		PAPER NUMBER		
2115				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,155

Applicant(s)

CHEN ET AL.

Examiner

Dennis M. Butler

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8-16 and 19-30 is/are rejected.
- 7) ☒ Claim(s) 2-4,7,17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

1. This action is in response to the application filed on May 31, 2006. Claims 1-30 are pending. This application is a 371 application of PCT/CN2004/000447 filed on May 8, 2004.

DETAILED ACTION

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6, 8, 13-15, 19, 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase "the verification" lacks proper antecedent basis because claim 1 recites two verifications, verification of an initialization table and verification of at least one initialization segment.

Claim 6 is rejected because they incorporate the deficiencies of claim 5.

Regarding claim 8, the phrases "the first and second keys" and "the at least one initialization segment" lack proper antecedent basis.

Regarding claims 13 and 23, the phrase "a memory ... to store an initialization table" is vague and indefinite as to whether an initialization table is stored in the memory. The examiner best understands the phrase as reciting an intended use of the memory because it is directed to an act to be performed in the future.

Claims 14-15 and 24-25 are rejected because they incorporate the deficiencies of claim 13 and 23.

Regarding claim 19, the phrases "the first and second keys" and "the at least one initialization segment" lack proper antecedent basis.

Regarding claim 26, the phrase "a secure store to perform one or more keys" is unclear as to its meaning.

Claims 27-30 are rejected because they incorporate the deficiencies of claim 26.

Regarding claim 29, the phrase "the first key" lacks proper antecedent basis.

Regarding claim 30, the phrases "the initialization segments", "the second keys" and "the signed initialization segments" lack proper antecedent basis.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9-12 and 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-12 and 20-22 are directed to a machine readable medium that has been disclosed in the specification at page 6, paragraph 21 as being a propagated signal such as a carrier wave. Applicant's claimed propagated signal having executable code is not statutory because it does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. The claimed propagated signal is directed to a form of energy. The claimed

signal/medium is not a process, composition of matter, a manufacture or a machine, it is a form of energy. The claim language would be statutory if applicant amended the claims to recite a machine-readable storage medium which would direct the claims to a storage medium and not to the transmission medium disclosed in the specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 9, 16, 20, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Zimmer et al., U. S. Patent Application Publication 2005/0149729.

Per claims 1, 9, 16, 20, 26 and 27:

Zimmer et al disclose generating a first key to sign an initialization table (the system table of figure 4 including the boot table) of a firmware (BIOS), signing the initialization table using the first key, storing the first key in a secure store and locking the secure store with figures 1, 4, 10b and 15a and at paragraphs 61-62, 70-73 and 121-124. Zimmer et al disclose retrieving the first key from the secure

store and verifying the initialization table using the first key with figures 4, 11a and 15a and at paragraphs 64, 67, 87-90 and 123-125.

8. Claims 13-15 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiseman et al., U. S. Patent Application Publication 2004/0003288.

Per claims 13-15 and 23-25:

Wiseman et al disclose a processor (CPU 124) and a memory (108) coupled to the processor to store an initialization table (policy table) with figures 1 and 2 and at paragraphs 14, 18, 19 and 23. Regarding the process recited in claims 13-15 and 23-25, the process is directed to functional descriptive material that is not stored in a computer readable media. Therefore, the functional descriptive material does not define any structural or functional relationships between the process and the claimed processor and memory. Therefore, the non-structural and non-functional process limitations are not deemed to have any patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ 2d 1525, 1528 (Fed. Cir. 1990). See MPEP 2114.

Allowable Subject Matter

9. Claims 2-4, 7, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis M. Butler whose telephone number is 571-272-3663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dennis M. Butler/
Primary Examiner, Art Unit 2115

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Primary Examiner
Art Unit 2115